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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/758,820      | 01/11/2001  | Swarupanda Ghosh     | P/2167-232          | 9254             |

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STEVEN I. WEISBURD ESQ.  
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP  
1177 AVENUE OF THE AMERICAS  
41ST FLOOR  
NEW YORK, NY 10036-2714

EXAMINER

MOONEYHAM, JANICE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3629

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/758,820

Applicant(s)

GHOSH ET AL.

Examiner

Jan Mooneyham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on August 12, 2004, wherein:  
Claims 1-41 are currently pending;  
Claims 1-36 have been amended;  
Claims 37-41 have been added;  
No claims were cancelled.

#### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

2. The applicant has amended claims 5, 17, and 18. Therefore, the rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 101***

3. The applicant has amended claims 18 – 31 and 34-36. Therefore, the rejection under 35 U.S.C. 101 is hereby withdrawn.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-5, 8-10, 12-23, 26-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Hollingsworth (US Patent 6,157,808) (hereinafter referred to as Hollingsworth).

Hollingsworth discloses a method and system for managing licensing information comprising:

obtaining licensing requirements information from a plurality of licensing authorities (col. 2, lines 43-45);

accessing a database coupled to at least one processor comprising entity information (col. 14, line 50-col. 15, line 23);

comparing by the processor the licensing requirements to the entity information to produce a comparison (Fig. 16 – Compliance certification, col. 2, lines 56-58, col. 3, lines 25-40)

determining the extent to which the comparison result indicates compliance (col. 3, lines 25-40, col. 4, lines 5-9, col. 15, lines 19-23).

Hollingsworth further discloses said licensing requirements information further comprises examinations for obtaining said license, said licensing requirements information further comprises continuing education for maintaining said license, said licensing requirements information is further comprised of information from at least one state entity responsible for administering licensing requirements (Figs. 2-16, col. 3, lines 25-40)

Hollingsworth further discloses identifying actions required by said at least one entity to obtain and maintain license and prompting the entity to take the required action (col. 2, lines 43-58, col. 3, lines 25-39).

Hollingsworth discloses notification of the comparison (Fig. 1A (310) completed evaluation).

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Hollingsworth discloses a system with databases and processors (claim 1 discloses a computerized training system, col. 5, line 66 thru col. 6, line 41, Figures 1A –16, col. 4, lines 26-35)

As per Claims 1-5, the type information is determined to be non-functional descriptive data and is given little patentable weight. Furthermore, the fact that the databases contain licensee agency information is considered to be non-functional descriptive data and is also given little patentable weight. The database in Hollingsworth and the processors are capable of performing the same function as the system in the applicant's invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into Hollingsworth the data of this invention since such data does not functionally relate to the structure and the subjective interpretation of the queries does not patentably distinguish the claimed invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 7, 11, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollingsworth.

Hollingsworth does not disclose that the at least one entity is an insurance agent or an insurance agency. However, these differences are only found in nonfunctional descriptive material and not material that is functionally involved in the structure, steps or method recited.

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Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to one of ordinary skill in the art to use the method and system of Hollingsworth with insurance agents and agencies because such data does not functionally relate to the structure or steps in the claims and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Response to Arguments***

Applicant's arguments filed August 12, 2004 have been fully considered but they are not persuasive.

First of all, the applicant argues that Hollingsworth does not show or suggest a source of licensing requirements information, said information including at least information related to obtaining and maintaining respective licenses with a plurality of licensing authorities. The Examiner directs the applicant to column 3, lines 33-40. for the invention in Hollingsworth to identify and report, for each employee job/task combination, that the employee is in compliance with all applicable statutes and regulations related to training, development and licensing, there must be information provided that has the necessary requirements provided so an assessment can be performed. Furthermore, column 2, lines 46-58 state that a qualification module includes performance information, compliance information, certification information, and evaluations. It is further states that the training module also includes a compliance means for evaluating the compliance information as it relates to each employee.

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As for the system claim, the applicant fails to understand that it is the structure that the Examiner is looking for in a system. While features of an apparatus/system may be recited either structurally or functionally, claims directed to an apparatus/system must be distinguished from the prior art in terms of structure rather than function alone. If the Examiner has reason to believe that a functional limitation can be performed by the prior art structure, the Examiner has established a prima facie case and the burden shifts to the applicant to prove otherwise. MPEP 2114, See *In re Swinehart*, 169 USPQ 226 (CCPA 1971); *In re Schreiber*, 44 USPQ 2d 1429 (Fed. Cir. 1997)

Furthermore, as for the method steps, much of the data there is found to be nonfunctional descriptive data also. Language or data that is not functionally interrelated with the useful acts will not serve as a limitation. Much of the information qualifies as descriptive material since it is directed to the information content and the steps are not altered by the type of information.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



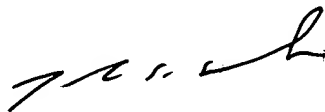
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600